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09/025,896 02/18/98 LONGSTRETH

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QM12/0825

EXAMINER

GOODMAN, C

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 08/25/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/025,896

Applicant(s)
Billie J. LONSTRETH

Examiner
Charles Goodman

Group Art Unit
3724



☒ Responsive to communication(s) filed on Jun 23, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 2 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 2 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. The substitute specification filed June 23, 1999 has not been entered because it does not conform to 37 CFR 1.125(b) because: (1) the statement as to a lack of new matter under 37 CFR 1.125(b) is missing, and (2) a marked-up copy of the substitute specification has not been supplied (in addition to the clean copy). This applies to the drawings with the substitute specification as well.
2. Since the *substitute specification* has not been entered, the following action on the merits deals only with the newly submitted claim and the specification as originally filed. With respect to the newly submitted claim, it is treated as having the same effect as canceling the original claim 1, and the newly submitted claim is referenced as claim 2.

Drawings

3. The drawings are objected to because the Figures lack reference numerals that indicate features of the invention, especially features relevant to the claimed subject matter. See 37 CFR 1.83 and 1.84. Correction is required. It is noted that, in general, the introduction of reference numerals in the *substitute specification* and the drawings would comply with the above requirements. However, since the *substitute specification* has not been entered, the above objection is maintained.

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Specification

4. The disclosure is objected to because of the following informalities:
- i) Pg. 1, Applicant is advised that if certain information is “Not Applicable”, i.e. “CROSS-REFERENCE TO RELATED APPLICATIONS”, “STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT”, and “REFERENCE TO A MICROFICHE APPENDIX”, then these sections should not be included in the specification. In other words, they are not necessary, and accordingly, they should be deleted.
 - ii) The specification lacks reference numerals to apprise one skilled in the art what features are discussed with respect to the Figures in the specification.
 - iii) It is noted that Applicant’s attempt to clarify the above matters in the *substitute specification* is, in general, a step in the right direction. However, since the *substitute specification* has not been entered, the above objections are maintained.
- Appropriate correction is required.

Claim Objections

5. Claim 2 is objected to because of the following informalities: claim 2 is not in one sentence form. The claim should begin with a capital letter and end with a period. See MPEP 608.01(m) and *Fressola v. Manbeck*, 36 USPQ2d 1211 (D.D.C. 1995). Appropriate correction is required.

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Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because the specification, as originally filed, does not provide support for the invention as now claimed. For example, the specification as originally filed does not support the specific dimensions of the body and cap nor does the specification support the specific claimed materials. To emphasize and clarify, the originally filed specification does not discuss anywhere the specific dimensions and materials of the various features of the invention nor does the original specification discuss the relevance or importance thereof. Without this type of information in the specification, the specification cannot support these features in the claim.

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7. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, for the reasons noted above.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 2 is rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph. Note the format of the claims in the patents cited, especially the recent patents.

- i) Claim 2 is vague and indefinite in that it is not clear what the claim encompasses. In l. 5, the term "it" is vague and indefinite. What is "it" referring to? The same applies to the rest of the claim. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex*

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parte Hall, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, the claim recites the broad recitation “a hard, strong metal with high tensile strength” (ll. 8-9), and the claim also recites “preferably stainless steel” (ll. 9-10) which is the narrower statement of the range/limitation. The same applies to similar phraseology in the claim. The following phrases lack clear antecedent basis: (ll. 11-12) “the cylindrical wall”, (ll. 16-17) “the cylindrical shaped wall”, (l. 18) “the user”, (l. 21) “the hand”, and (ll. 22-23) “the cutting and chopping portion.” In l. 22-23, the phrase “the cutting and chopping portion” is vague and indefinite in that it is not clear what the phrase encompasses. What is the difference, if any, between this and the “cutting and chopping means” previously recited? If none, then consistent terminology for the same feature should be maintained throughout the claim. In ll. 27-30, the phrase “The cabbage cutter device...cabbage” is not clearly understood. How is this further defining the invention? This type of phraseology relates to the purported merits of the invention as opposed to the actual structural features of the invention. Applicant is advised to limit the claim to reciting the features of the device.

- ii) It is again noted that Applicant is *pro se*. Thus, if Applicant requires further assistance on this issue or anything else, Applicant is invited to call the Examiner. The contact information is listed below. Moreover, Applicant is advised to review

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the recent patents included in this Office Action for further guidance on the issues discussed above including the specification and drawing objections.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 2 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bundy.

Bundy discloses a dehorner comprising all the elements claimed including a hollow metal cylindrical body 1, a closed top (at 9 in the Figures), a cutting means 2 or 3, a cap 9, and a cover 13 wherein the device appears to include the dimensions as claimed. However, if it is argued that Bundy lacks the dimensions as claimed, then it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Bundy with the dimensions as claimed in order to facilitate a cutting device of a proportion more comfortable to the user, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art, especially since such a change does not render unexpected or unobvious results. *In re Rose*, 105 USPQ 237 (CCPA 1955).

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Regarding the work piece being cabbage, it has not been given significant patentable weight, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rothje in view of Bundy.

Rothje discloses the invention substantially as claimed including a cylindrical body 1, a cutting means 2, and a cap 5 (see Figs. 104) except for a cover. However, Bundy teaches a cover 13 for the purpose of protecting the interior of the hollow cutter 1 from dust and grit. See Figs. 1-2, p. 1, ll. 98-103. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Rothje with the cover as taught by Bundy in order to protect the device from undesirable material during non use of the device.

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Regarding the work piece being cabbage, it has not been given significant patentable weight, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Response to Arguments

14. It is noted that Applicant failed to present any arguments in the Amendment filed June 23, 1999 traversing the rejection of the claim from the last Office Action. However, it is also noted that even if Applicant had submitted such arguments, it would have been considered but are moot in view of the new ground(s) of rejection.

Applicant is advised that if any questions exists with respect to the contents of the instant Office Action, Applicant is invited to telephone the Examiner on these issues. The contact information is listed below.

Conclusion

15. An examination of this application reveals that applicant is not completely familiar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

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Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached on (703) 308-2187. The fax phone number for this Group is (703) 305-3579.

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Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [rinaldi.rada@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

cg 
August 23, 1999

Charles Goodman
Patent Examiner
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Rinaldi I. Rada
Supervisory Patent Examiner
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